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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,903	07/10/2003	Joost Alexander Spierenburg	U 014712-9	3487

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LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NY 10023

EXAMINER

JOHNS, ANDREW W

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/616,903	Applicant(s) SPIERENBURG	
	Examiner Andrew W. Johns	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-22 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-19,21 and 22 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-16,20 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see page 12 of the response, filed 29 April 2005, with respect to the rejections under 35 U.S.C. § 112 and 102 have been fully considered and are persuasive. The rejections under 35 U.S.C. § 112 and 102 have been withdrawn.

2. Applicant's arguments filed 29 April 2005 with respect to the rejection under 35 U.S.C. § 101 have been fully considered but they are not persuasive.

Applicant argues that the amendments to claims 1, 12, 13, 15 and 20, defining a carrier structure resolves the resolves the issue under 35 U.S.C. § 101. However, these amendment are insufficient to resolve this issue with respect to these claims. Specifically, as pointed out more fully in the previous office action, these claims are directed towards non-functional descriptive material, namely a digital security image. These images do not, in and of themselves, impart any specific functionality on a general purpose computer or machine, so that they cannot be considered to be functional descriptive material. Such non-functional descriptive material is not statutory, even when recited in a computer-readable medium (see M.P.E.P. § 2106). While the claims now require the digital security image to be embodied "in a carrier," this language fails to define a specific product that would be considered statutory. While a specific, physical product bearing such an image constitute a statutory product under 35 U.S.C. § 101, the instant claims do not define any such specific, physical product. Instead, the claim language encompasses any "carrier" and are only defined by the data embodied in the carrier. Therefore, these claims remain directed towards the non-functional descriptive material, and are not considered to be directed towards statutory subject matter.

In contrast, the amendments to claims 21 and 22 do resolve the issues under 35 U.S.C. § 101, because these claims are directed towards software, which is functional descriptive material (i.e., it imparts functionality on a general purpose computer), and the claims now require this software to be embodied on a computer-readable medium so that the functionality can be fully realized by such a computer system. Therefore, claims 21 and 22, as amended, are now directed towards statutory subject matter.

Claim Rejections - 35 U.S.C. § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 27 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The requirement of claim 27 that the first security characteristic in the Fourier domain be in a range having a frequency higher than 800 dpi is confusing, because it contradicts the requirement of claim 13 (from which claim 27 depends) that this characteristic have a frequency between 150 and 400 dpi. Because 800 dpi is not within the range of 150 to 400 dpi, it is unclear what frequency this characteristic might have or how the two ranges are related. It would appear that the language of claim 27 might better require that the *second* characteristic have a frequency higher than 800 dpi, which would correspond to the original language of claim 13 canceled in the instant amendment.

Claim Rejections - 35 U.S.C. § 101

5. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5 6. Claims 1-2, 5-16, 20 and 25-27 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

10 Claims 1-2, 5-16, 20 and 25-27 are directed towards a “carrier” having a “digital security image.” None of these claims are actually directed towards any tangible product itself, but are instead these claims are directed toward any carrier having the claimed digital image, which is descriptive material or data. Descriptive material can be classified as either functional or non-
15 functional. Functional descriptive material (i.e., computer programs or specific data structures) impart specific functionality on a general purpose computer and serve to modify the general purpose computer so that it becomes a specialized computer system. However, functional descriptive material, *per se*, is not a tangible product of manufacture, so that functional
20 descriptive material is only considered statutory when embodied in a computer-readable storage medium so as to constitute a tangible product of manufacture. Non-functional descriptive material is *never* considered to be statutory subject matter, in that it imparts no new and useful functionality on a general purpose system and only distinguishes over other descriptive material by the descriptive content. See M.P.E.P. § 2106.

20 The digital image variously defined in claims 1-2, 5-16, 20 and 25-27 does not impart any functionality on a general purpose computer, so that it constitutes non-functional descriptive material, so that these claims are directed towards non-statutory subject matter.

Allowable Subject Matter

7. Claims 17-19 and 21-22 are allowed.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

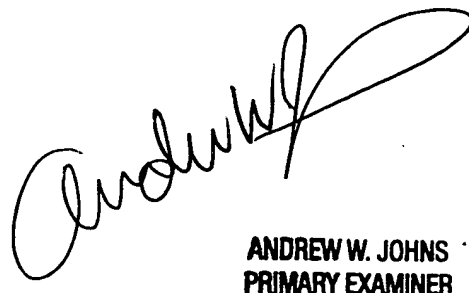
5 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10 9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Johns whose telephone number is (571) 272-7391. The examiner is normally available Monday through Friday, at least during the hours of 9:00 am to 3:00 pm Eastern Time. The examiner may also be contacted by e-mail using the address: andrew.johns@uspto.gov. (Applicant is reminded of the Office policy regarding e-mail communications. See M.P.E.P. § 502.03)

20 If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Joseph Mancuso, can be reached at (571) 272-7695. The current fax phone number for this art unit is (703) 872-9306. However this number is scheduled to change and beginning July 15, 2005, faxes should be sent to (571) 273-8300. In order to ensure prompt delivery to the examiner, all unofficial communications should be clearly labeled as "Draft" or "Unofficial."

25 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center Receptionist whose telephone number is (571) 272-2600.

30 A. Johns
6 July 2005



ANDREW W. JOHNS
PRIMARY EXAMINER